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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,112	03/01/2000	Hiroyuki Fujiyoshi	862.C1854	3021

5514 7590 05/09/2003

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EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 05/09/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/516,112

Applicant(s)

FUJIYOSHI, HIROYUKI

Examiner

Bunjoo Jaroenchonwanit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 0203.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 02 April 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. This application has been reviewed. Original claims 1-94 are pending, the objections and rejections cited are as stated below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-4, 6, 10, 16-17, 20-24, 26, 30-31, 37-38, 41-44, 46, 50, 56-57, 60-64, 66, 70-71, 77-78 and 93-94 are rejected under 35 U.S.C. 102(e) as being anticipated by Shirai et al (US.6, 466,968).

4. As to claims 20 and 60, Shirai an apparatus, a method steps and sets of computer instructions (hereinafter a “system”) for construction and communication e-mails and their attached files (See abstract and claims). The system comprising means, steps and instructions for generating e-mails, including attachment files and instructions how to access the attachment files

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(i.e., a generating step of generating electronic mail information which includes access information relating to an object to be attached to electronic mail) (See Fig. 4A, 401-405; Fig. 4B, 407-408; Fig. 5, S11-S14);

means, steps and instructions for communicating the e-mails and the attachment files *(i.e., a communication step of sending and receiving the electronic mail information generated at said generating step) (See Fig. 3B, 301b, 302305, 306b; Fig. 5, S16; Fig. 6, S24); and*

means, steps and instructions for access the attachment files based on the access information (See Fig. 4, 405, 407-408; Fig. 6, S25), *(i.e., an access step of accessing the object based upon the access information contained in the electronic mail information received via said communication step).*

5. As to claims 1, 21, 41, 61 and 93, Shirai discloses means, steps and instructions for generating an attached file (Fig. 22, 301c, Fig. 20, S54, Col. 12, 25-32) *(i.e., a designating step of designating a desired object to be attached to electronic mail);*

Further, Shirai discloses a means, steps and instructions for a designator unit for designate access method (Fig. 22, 301i; Col. 13, lines .42-44) *(i.e., an acquisition step of acquiring access information relating to the object designated at said designating step); and*

Furthermore, Shirai discloses a means, steps and instructions for including access information in the e-mail messages, for using as instruction, by e-mail recipient, to access and/or handling the attachment file (Fig. 4, 19; Col. 5, lines 43-52; Col. 12, lines 32-40) *(i.e., mail information generating step of generating electronic mail information in which the access information acquired at said acquisition step constitutes part of the electronic mail).*

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6. As to claims 2, 22, 42 and 62, Shirai discloses means, steps and instructions for generating attachment file and designating access method (Col. 5, lines 43-56) (*i.e., mail information generating step generates an attachment file which includes the access information acquired by said acquisition step and attaches the generated attachment file to electronic mail that is to be transmitted*).

7. As to claims 3, 23, 43 and 63, Shirai discloses means, steps and instructions for merging an attachment file and access method into e-mail message (Col. 5, lines 57-61) (*i.e., said mail information generating step affixes the access information, which has been acquired at said acquisition step, to a main body of electronic mail that is to be transmitted*).

8. As to claims 4, 24, 44 and 64, Shirai discloses means, steps and instructions for generating an URL for accessing an attachment file (Fig. 4B; Col. 5, lines 56-58) (*i.e., the access information includes information indicating a storage location of the object, which has been designated at said designating step, in the system*).

9. As to claims 6, 26, 46 and 66, Shirai discloses means, steps and instructions for allowing e-mail users to set access method via e-mail attached file edit window (Fig. 19; Col. 4, lines 52-53) (*i.e., acquisition step includes a setting step of allowing a user to set access information via a prescribed user interface*).

10. As to claims 30, 70, Shirai discloses means, steps and instructions for transmitting e-mail, attachment and other desirable information to e-mail recipients (Fig. 1, 103-104) (*i.e., communication step transmits the electronic mail information, which has been generated at said generating step, to an information processing apparatus that has been designated*).

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11. As to claims 16, 17, 56, 57, 37, 38, 77 and 78, Shirai discloses means, steps and instructions for extracting access method (Col. 20, lines 8-9) (*i.e., said extraction step extracts the access information from a file that has been attached to electronic mail*).

12. As to claims 10, 31, 50, 71 and 94, Shirai discloses the system includes means, step and instructions for:

an extraction step of extracting the access information contained in electronic mail that has been received (Col. 14, lines 50-51);

an object access step of accessing an object based upon the access information extracted at said extraction step (Col. 14, lines 52-53); and

a display step off presenting a display that corresponds to the object based upon a content of the object accessed at said access step (Col. 15, lines 40-45).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 5, 11, 25, 45, 51, 65 and 72, are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirai et al (US.6, 466,968), as applied to claims 1, 10, 20, 41, 51 and 60 above, and further in view of Holtz (US. 6,433,800).

15. As to claims 5, 11, 25, 45, 51, 65 and 72, Shirai discloses the invention substantially as claim but fails to disclose *a thumbnail of documents, and displaying an icon corresponding to an*

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electronic mail application; and designating a desired by dropping the document on to the icons.

However, in an analogous art, to improve over a conventional system (Col. 2, lines 28-52), Holtz teaches a graphical method invocation method, and associated method for computer system, which capable of displaying list of e-mails and attached objects in at a glance form, icons, and capability of allowing objects to be designated to the icons and list by way of drag and drop (Fig. 2, items 54, 44, 46 and 48; Col. 25, lines 3-16; Fig.6-8 and corresponding details in Col. 6, line 62-Col. 7, line 40). Thus, taking advantage of Holtz suggestions would have been obvious to one of ordinary skill in the art at the time of the invention was made. Because, it would enable users to easily select and/or view multiple attached objects in a short time and less interventions from the users, thereby, increasing users' conveniences and the system could be more attractive to the users.

16. Claims 7-9, 18-19, 27-28, 39-40, 47-49, 58-59, 67-69 and 79-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirai et al (US. 6,466,968), as applied to claims 1, 10, 20, 41, 51 and 60 above, and further in view of Uchida et al (US. 6,327,610).

17. As to claims 7-9, 18-19, 27-29, 39, 40, 47-49, 58, 59, 67-69 and 79-80, Shirai discloses the invention substantially, including attachment access information, as claimed, as described in claims 1, 41, 21, and 61. Shirai does not explicitly disclose the access information includes an access key for logging in the storage location. However, in the same field of endeavor, motivated by intention to eliminate wasteful bandwidth of transmitting unnecessarily e-mails, Uchida embedded an access code in the e-mail body for e-mail subscribers to access, e.g., log in, the mails server to receive e-mail messages, (Col. 3, lines 2-6; Col. Fig. 3, 306; Fig. 4, 412-415). Thus, modifying Shirai by taking advantage from Uchida's teaching would have obvious to one

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of ordinary skill in the art at the time of the invention was made. Because the modification would enable one to control amount of e-mail transmission over the network, preventing enormous traffic, specially traffic generated from e-mail attachment, which would consume large amount of network bandwidth, thereby minimizing utilization and operation cost, and further strengthen e-mail security and user privacy.

18. As to claims 81-92, as discussed in the above paragraphs, Shirai-Uchida discloses the invention substantially, as claimed, including attachment access information, sending access code to subscribers, i.e., registered users, and preventing non subscribers to access the information, by sending access code to its subscribers only. Shirai-Uchida does not explicitly disclose *setting whether or not to provide the access information, password, to unregistered user*. However, having a system to decide whether or not to send access information to a specific users, e.g., unregistered, would have been obvious to one of ordinary skill in the art at the time of the invention was made that was a matter of design choice that clearly depended on applications' requirements. Because allowing sending access information to all users, (e.g., subscribers and non-subscribers), the system would capable of sending e-mails to new users, which could be used and most required for advertising and products marketing.

19. Claims 12-15, 33-36, 52-55 and 73-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirai et al (US.6, 466,968), as applied to claims 10, 31, 50 and 71 above, and further in view of Uchida et al (US. 6,327,610) and Holtz (US. 6,433,800).

20. As to claims 12-15, 33-36, 52-55 and 73-76, Shirai discloses the invention substantially as claim, including means, steps and instructions for displaying e-mail, attached objects and accessing method as described, *supra*. Shirai does not explicitly include conventional

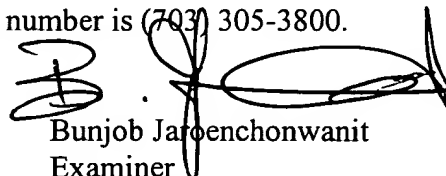
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permission information, such as password, etc. and thumbnail or at a glance feature. However, in analogous arts, Uchida teaches an e-mail system, which including using access code to access e-mail and Holtz teaches an e-mail system which include using icons that enable users to glance at the icons and list of object associated with the icons (See citation in paragraphs 15- and 17). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made that to modify Shirai's system with conventional concepts, as suggested by Holtz and Uchida, in order to have an e-mails system that secure, easy to use and highly efficiencies. Because simplifying utilizations, securing and increasing efficiency are keys of having a system that attract users, thereby easily to market.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.



Bunjob Jaroenchonwanit
Examiner
Art Unit 2141

/bj
May 5, 2003